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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,031	10/19/2000	Richard Baker Winslow	37631/DWR/S850	5435

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EXAMINER

PHAM, HUNG Q

ART UNIT PAPER NUMBER

2168

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/692,031	WINSLOW, RICHARD BAKER	
Examiner	Art Unit	
HUNG Q. PHAM	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 and 49-53 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 and 49-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Office Action was returned to the Office because the United States Postal Service has not been able to deliver. The Office Action was remailed on 08/21/2006 and the Applicants' representative, Dan Ferris, informed that the remailed Office Action had not been received. According to the request from Applicant's representative, the Office Action is remailed a second time. The remailing date establishes the beginning of the period for reply in view of MPEP 710.06.

Election/Restrictions

Claims 11-17 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/22/05.

This application contains claims 11-17 drawn to an invention nonelected without traverse in Paper 08/22/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

Applicant's arguments with respect to claims 18-23 and 49-53 have been considered but are moot in view of the new ground(s) of rejection.

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Claim Objections

Claims 50 and 52 are objected to because of the following informalities: *the companion file*, and *the database of valid addresses*. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As in claim 18, the steps of *selecting an address from the results*, and *printing the selected address on the VBI* were not described in the specification.

As in claim 49, the steps of *selecting a validated address from the displayed results*, and *printing the selected address on the VBI* were not described in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 18-20 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jatkowski [USP 6,457,012 B1] in view of Gardner et al. [USP 6,701,352].

Regarding claim 18, Jatkowski teaches a method for matching an address with a database of pre-approved addresses. The Jatkowski method comprising:

storing a plurality of pre-approved addresses with a predetermined format in the database (FIG. 1, database 28 is National Change of Address Database or NCOA contains a list of changed addresses (Col. 5, Lines 3-4), input data has to be reformatted in order to compare with NCOA (Col. 4, Lines 50-54 and Col. 5, Lines 1-4). As seen, a list of changed addresses as *a plurality of pre-approved addresses* is stored in NCOA database, and the technique of reformatting the input data implies NCOA has *a predetermined format*);

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receiving address data with different formats (the step of *receiving address data* is disclosed at Col. 4, Lines 50-51, the address data has to be reformatted in order to compare with NCOA (Col. 4, Lines 50-54 and Col. 5, Lines 1-4). The technique of reformatting the input data implies the address data has a *different format* with NCOA);

mapping the received address data with the different formats into a the predetermined format (Col. 4, Lines 50-54);

comparing the received address data in the predetermined format to the pre-approved addresses in the database for validating the address (Col. 4, Line 65-Col. 5, Line 19);

The missing of Jatkowski method is the step of *displaying the results for selection by a user, if one or more matches are found, selecting an address from the result, and printing the selected address on the VBI*.

However, as disclosed by Jatkowski, Smart Mailer is software for use at the client side (Col. 4, Lines 31-36), wherein a mailing list correction scheme can be used (Col. 4, Lines 59-58). After the step of comparing, the matching address is utilized to update the local database (Col. 5, Lines 13-17).

Gardner teaches a method of matching address (Gardner, Abstract) and using Smart Mailer program (Gardner, Col. 5, Lines 39-40) for *displaying the results for selection by a user, if one or more matches are found, selecting an address from the result, and printing the selected address on the VBI* (Gardner, Col. 5, Lines 52-59 and Col. 12, Line 61-Col. 13, Line 7).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the step of displaying the results and printing the selected address in order to manage an address returns from a list of changed addresses for printing.

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Regarding claim 19, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 18, Jatkowski further discloses the step of *accessing a remote database of addresses over a communication network* (Jatkowski, FIG. 1, Col. 3, Line 50-Col. 4, Lines 16).

Regarding claim 20, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 19, Jatkowski further discloses *the database is maintained by a remote address matching server* (Jatkowski, FIG. 1, Col. 3, Line 50-Col. 4, Lines 16).

Regarding claim 49, Jatkowski teaches a method for matching an address. The Jatkowski method comprising:

storing a plurality of pre-approved addresses a database (FIG. 1, database 28 is National Change of Address Database or NCOA contains a list of changed addresses (Col. 5, Lines 3-4), input data has to be reformatted in order to compare with NCOA (Col. 4, Lines 50-54 and Col. 5, Lines 1-4). As seen, a list of changed addresses as *a plurality of pre-approved addresses* is stored in NCOA database, and the technique of reformatting the input data implies NCOA has *a predetermined format*);

receiving address data from a user using a terminal remote from the database over a wide area network (the step of *receiving address data from a user using a terminal* is disclosed at Col. 4, Lines 36-40 and 50-51, the method is implemented *over a wide area network* (Col. 3, Line 59-Col. 4, Line 16));

accessing the database from a server that is communicating with the terminal over the wide area network (Col. 4, Line 65-Col. 5, Line 1);

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comparing the address received from the terminal to the database of pre-approved addresses (Col. 5, Lines 1-6);

transmitting the comparing results to the remote terminal (Col. 5, Lines 7-11);

The missing of Jatkowski method is the step of *displaying the results on the remote terminal, selecting a validated address from the displayed results, and printing the selected address on the VBI*.

However, as disclosed by Jatkowski, Smart Mailer is software for use at the client side (Col. 4, Lines 31-36), wherein a mailing list correction scheme can be used (Col. 4, Lines 59-58). After the step of comparing, the matching address is utilized to update the local database (Col. 5, Lines 13-17).

Gardner teaches a method of matching address (Gardner, Abstract) and using Smart Mailer program (Gardner, Col. 5, Lines 39-40) for *displaying the results on the remote terminal, selecting a validated address from the displayed results, and printing the selected address on the VBI* (Gardner, Col. 5, Lines 52-59 and Col. 12, Line 61-Col. 13, Line 7).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the step of displaying the results and printing the selected address in order to manage an address returns from a list of changed addresses for printing.

Regarding claim 50, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Jatkowski further discloses the step of *storing information relating to the validated address in the companion file upon a validation of the address* (Jatkowski, Col. 5, Lines 12-17).

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Regarding claim 51, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Jatkowski further discloses the step of *importing the address from a database of addresses* (Jatkowski, Col. 5, Lines 7-19).

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jatkowski [USP 6,457,012 B1], Gardner et al. [USP 6,701,352] as applied to claim 18 above, and further in view of Wesinger, Jr. et al. [USP 6,324,538 B1] .

Regarding claim 21, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 18, but does not explicitly teach the step of *applying a plurality of query permuters to the address data to convert the data into respective formats*. Wesinger discloses the step of *applying a plurality of query permuters to the address data to convert the data into respective formats* (Wesinger, FIG. 2K). It would have been obvious for one of ordinary skill in the art at the time the invention was made to use query permuters as taught by Wesinger with Jatkowski and Gardner method in order to format the address data.

Regarding to 22, Jatkowski, Gardner and Wesinger, in combination, teach all of the claimed subject matter as discussed above with respect to claim 21, Wesinger further discloses the step of *applying at least one of a direct permuter and a single line permuter to the address data* (Wesinger, FIG. 2K).

Regarding claim 23, Jatkowski, Gardner and Wesinger, in combination, teach all of the claimed subject matter as discussed above with respect to claim 22, Wesinger

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further discloses the step of *applying a truncate permuter to the output structure of the direct permuter* (Wesinger, Col. 8, lines 37-52).

Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jatkowski [USP 6,457,012 B1] , Gardner et al. [USP 6,701,352] as applied to claim 18 above, and further in view of in view of Pierce et al. [USP 5,930,796].

Regarding claim 52, Jatkowski and Gardner, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Jatkowski further discloses the step of *accessing the database of valid addresses if no match is found* (Jatkowski, FIG. 2). The missing of Jatkowski and Gardner is the steps of *receiving a second address from the user; comparing selected information from the second address with stored information in the companion file; approving the address for use if the selected information corresponds with the stored information in the companion file.*

Pierce teaches a method of validating an address for printing on an envelope or label as value bearing item (VBI), Pierce further discloses the steps of *receiving a second address from the user; comparing selected information from the second address with stored information in the companion file; approving the address for use if the selected information corresponds with the stored information in the companion file* (Pierce, FIG. 2).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have the steps of receiving a second address for comparing with a companion file in order to reduce the time of validating an address.

Regarding claim 53, Jatkowski, Gardner and Pierce, in combination, teach all of the claimed subject matter as discussed above with respect to claim 52, Pierce further

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discloses the step of *determining whether a stored address in the companion file is stale, and rejecting the stored address if it is stale* (Pierce, Col. 4, Line 62-Col. 5, Line 19).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HUNG Q PHAM
Examiner
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November 2, 2006